THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES M. HATTON

Appeal No. 96-3699
Application 08/063,407[1]

ON BRIEF

Before URYNOWICZ, THOMAS and HAIRSTON, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-6, 8 and 9, all the claims pending in the application.

The invention pertains to a method of using digitally stored information to create ideas and solve

[1] Application for patent filed May 18, 1993.

problems. Claim 1 is illustrative and reads as follows:

1. A method of using digitally stored information to create ideas and solve problems, comprising the steps of:

(a) receiving an input statement identifies a problem to be solved;

(b) identifying at least one word in said input statement, said at least one word being an object of a verb, the action of said verb occurring upon solution of said problem;

(c) receiving a first data base that contains information relating to a first system and that relates to said problem to be solved;

(d) receiving a second data base that contains information relating to a second system;

(e) locating an entry in said first data base that corresponds to said object;

(f) determining the hierarchical level of said entry in said first data base;

(g) obtaining data relating to a process from said second data base at said hierarchical level in said second data base; and

(h) substituting said object for at least one word in said process data.

The references relied upon by the examiner as evidence of obviousness are:

Bourne	4,787,035	Nov. 22, 1988
Prager	5,255,386	Oct. 19, 1993
		(filed Feb. 08, 1990)

The appealed claims stand rejected as under 35 U.S.C. § 103 as being unpatentable over Prager in view of Bourne.

The respective positions of the examiner and the appellant with regard to the propriety of these rejections are set forth in the final rejection (Paper No. 12) and the examiner's answer (Paper No. 18) and the appellant's brief (Paper No. 17) and reply brief (Paper No. 19).

Appellant's Invention

The invention is a method of artificial intelligence. The method uses a second existing data base (i.e., a human data base including data on skin transplants) to solve a problem (i.e., damaged tree bark) where an existing solution is not found in a first data base (i.e., a tree data base). Thus, a computer can create a new solution to the problem using a second, existing data base by substituting a new term or data from the first data base (i.e., bark) for a term or data in the second data base (i.e., skin). Thus, in the given example, "skin transplant" would become "bark transplant". The data of the second data base involving information concerning humans is not directly related to the problem to be solved.

Another aspect of the invention is that data bases used with the invention are organized in a hierarchy of different levels. The existing data into which new data is substituted must be obtained from the correct level in the data base.

The Prior Art

Prager discloses a data processing system which suggests a valid command to a user when the user has entered an erroneous question or command. With respect to Figure 3, inference engine 32 and rules base 34 form an expert system for analyzing the inputs from a user at 36 for solving the

problem defined thereby. Rules base 34 is a knowledge base and engine 32 is the problem solver. Together they operate on an incorrect input and convert it to a sequence of commands and/or actions which do what the system guesses the incorrect input is attempting to do, or take a goal and generate a sequence of commands and/or actions which will achieve the goal. The commands and/or actions are presented to the user as suggestions. Generator 48 uses trace 46 to search through templates 50 and produces complementary explanations 56 of why suggestions 54 were made and explanations 58 of how such suggestions work.

In Figure 2A, Bourne discloses a hierarchical arrangement of workspaces which can perform useful tasks. The workspaces can be in a single computer or separate computers.

The Rejection under 35 U.S.C. §103

It is the examiner's position that Prager teaches all the limitations of the claims with the exception that Prager does not teach the subject matter of paragraph (f), the step of determining the hierarchical level of the data entered in a data base. Bourne is asserted to teach the exception, and the examiner contends that it would have been obvious for one of ordinary skill in the art at the time the invention was made to combine Prager's method for solving problems with Bourne's hierarchical arrangement in order to allow Prager's method to find words in a different database at the same level, thus allowing Prager's method to solve problems more efficiently (faster).

Opinion

After consideration of the positions and arguments presented by both the examiner and the appellant, we have concluded that the rejection of independent claim 1 should not be sustained.

The examiner has not set forth adequate motivation for combining the teachings of Prager and Bourne. It is not evident that by combining Bourne's hierarchical teaching with Prager, one of ordinary skill in the art at the time the invention was made would have expected that Prager's method would actually solve problems more efficiently (faster) and there is no analysis of Prager's method showing that this is the case. To the contrary, the data bases 34 and 50 of Prager's Figure 3 do not exchange or substitute data. Thus, providing hierarchical levels therein would not speed up data substitution and problem solving as in appellant's invention where information is substituted between data bases. Accordingly, improved efficiency of carrying out Prager's method does not appear to be motivation for combining the teachings of Prager and Bourne.

The examiner has provided no other motivation for combining the teachings of this prior art. The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

Even if there were some suggestion or incentive to combine the teachings of the two references, we would not sustain the rejection. Paragraph (h) of claim 1 requires substituting said object, which is derived from a first data base, for at least one word in the process data, which is derived from a second

data base. The examiner has identified the two data bases as rule base 34 and templates 50 in Figure 3 of Prager. However, as noted above, there is no substitution of data between elements 34 and 50 in Prager and, consequently, there can be no substituting of an object from one data base for at least one word in the process data from a second data base. Otherwise, it has not been shown that the subject matter of Paragraph (h) involves an obvious modification of Prager and Bourne. In re Fritch, supra.

Whereas claims 2-6, 8 and 9 depend from claim 1, the rejection of these claims will not be sustained.

REVERSED

STANLEY M. URYNOWICZ, JR Administrative Patent Judge	)
JAMES D. THOMAS Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
KENNETH W. HAIRSTON Administrative Patent Judge	)

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